

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Todd A. Thompson et al.

Group: 3737

Serial No.: 09/935,908

Examiner: Unknown

Filed: 23 August 2001

For: Systems and Methods for Applying Ultrasonic Energy to the Thoracic Cavity

Commissioner of Patents and Trademarks
Washington, D.C. 20231
ATTENTION: Application Division

COPY OF PAPERS
ORIGINALLY FILED

COMPLETION OF FILING REQUIREMENTS

(check and complete this item, if applicable)

- I. ☒ This replies to the Notice to File Missing Parts of Application (PTO-1533) mailed
20 September 2001.

NOTE: If these papers are filed before the office letter issues adequate identification of the original papers should be made, e.g., in addition to the name of the inventor and title of invention, the filing date based on the "Express Mail" procedure, the serial number from the return post card or the attorney's docket number added.

- ☒ A copy of the Notice to File Missing Parts of Application-Filing Date
Granted (Form PTO-1533) is enclosed.

NOTE: The PTO requires that a copy of Form PTO-1533 be returned with the response to the notice to file missing parts to the application.

DECLARATION OR OATH

- II. ☒ No original declaration or oath was filed and enclosed is the original declaration or oath for this application.

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being transmitted therewith) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Mary Szollar

(Type or print name of person mailing paper)

Date: 13 November 2001

(Signature of person mailing paper)

- ☐ The original declaration or oath which was filed was determined to be defective. A new original oath or declaration is attached.

NOTE: 37 CFR 1.41(a) points out that "Full names must be stated, including the family name and at least one given name without abbreviation together with any other given name or initial."

NOTE: For surcharge fee for filing declaration after filing date complete item VI(3) below.

NOTE: Acceptable minimums in the declaration for identification of the specification to which it applies are the name of the inventor AND (1) SERIAL NUMBER (2) ATTORNEY DOCKET NUMBER WHICH WAS ON THE APPLICATION AS FILED AND THE FILING DATE (3) TITLE OF THE INVENTION AND FILING DATE (4) TITLE OF INVENTION AND REFERENCE TO A SPECIFICATION WHICH IS ATTACHED TO THE DECLARATION AT THE TIME OF EXECUTION AND FILED WITH THE DECLARATION OR (5) TITLE OF INVENTION AND A STATEMENT BY A REGISTERED ATTORNEY THAT THE APPLICATION FILED IN THE PTO IS THE APPLICATION WHICH THE INVENTOR EXECUTED BY SIGNING THE DECLARATION. IF IDENTIFICATION (4) IS USED IT MUST BE ACCOMPANIED BY A STATEMENT THAT THE "ATTACHED" SPECIFICATION IS A COPY OF THE SPECIFICATION AND ANY AMENDMENTS THERETO WHICH WERE FILED IN THE PTO TO OBTAIN THE FILING DATE; SUCH A STATEMENT MUST BE A VERIFIED STATEMENT IF MADE BY A PERSON NOT REGISTERED TO PRACTICE BEFORE THE PTO. NOTICE OF SEPTEMBER 12, 1983 (1035 O.G. 3).

NOTE: Another minimum found acceptable in the declaration is the filing date (i.e., date of express mail) and the express mail number, useful where the serial number is not yet known. But note the practice where the express mail deposit is a Saturday, Sunday or holiday within the District of Columbia. 37 CFR 1.10(c).

(complete (c) or (d), if applicable)

Attached is a

- (c) ☒ Statement by a registered attorney that the application filed in the PTO is the application which the inventor executed by signing the declaration.
- (d) ☐ Statement that the "attached" specification is a copy of the specification and any amendments thereto which were filed in the PTO to obtain the filing date.

AMENDMENT CANCELLING CLAIMS

- III. ☐ Cancel claims _ inclusive.

TRANSMITTAL OF ENGLISH TRANSLATION OF NON-ENGLISH LANGUAGE PAPERS

IV.

- ☐ Submitted herewith is a verified English translation of the non-English language application papers as originally filed. It is requested that this translation be used as the copy for examination purposes in the PTO.

NOTE: For fee processing a non-English application complete item VI(5) below.

NOTE: A non-English oath or declaration in the form provided or approved by the PTO need not be translated. 37 CFR 1.69(b).

NOTE: The translation for a regular application filed in a foreign language must be verified. 37 CFR 1.52(d).

SMALL ENTITY STATUS

V.

☒ The applicant is a small entity and is entitled to Small Entity Status.

VI.

COMPLETION FEES

WARNING: Failure to submit the surcharge fees where required will cause the application to become abandoned. 37 CFR 1.53(d).

NOTE: The filing fees, fees for claims and surcharge fees listed below in items 1, 2 and 3 are reduced by 50% where proof of a small entity status is established on or before the date the fee is paid. If the full fee was paid but a verified statement is filed within 2 months of the date of timely payment of a fee then the excess fee paid will be refunded on request. 37 CFR 1.28(a).

1. Filing fee

☒ original patent application (37 CFR 1.16(a))
\$740.00; Small entity-\$370.00 \$ 370.00

☐ design application (37 CFR 1.16(f))
\$330.00; small entity-\$165.00 \$

2. fees for claims

☒ each independent claim in excess of 3
(37 CFR 1.16(b)-\$84.00; small entity-\$42.00) \$ 42.00

☒ each claim in excess of 20
(37 CFR 1.16(c)-\$18.00; small entity-\$9.00) \$ 180.00

☒ multiple dependent claim(s)
(37 CFR 1.16(d)-\$280.00; small entity-\$140.00) \$ 140.00

3. surcharge fees

☒ late payment of filing fee

and/or

☒ late filing of original declaration or oath
(37 CFR 1.16(e)-\$130.00; small entity-\$65.00); \$ 65.00

NOTE: Even where a facsimile declaration or oath signed by the inventor(s) was part of the originally filed papers the surcharge fee is required.

NOTE: If both the filing fee and declaration or oath were missing from the original papers only one surcharge fee for both need be paid. 37 CFR 1.16(e).

4. ☐ petition and fee for filing by other than all the inventors
or a person not the inventor
(37 CFR 1.17(h) and 1.47-\$130.00) \$

5. ☐ fee for processing an application filed with a specification
in a non-English language
(37 CFR 1.17(k) and 1.52(d)-\$130.00) \$

6. ☐ fee for processing and retention of application (37 CFR 1.21(l) and 1.53(d)) - \$300.00 \$ _____

NOTE: 37 CFR 1.21(l) establishes a fee for processing and retaining any application which is abandoned for failing to complete the application pursuant to 37 CFR 1.53(d) and this, as well as, the changes to 37 CFR 1.53 and 1.78 indicate that in order to obtain the benefit of a prior U.S. application, either the basic filing fee or the processing and retention fee of S 1.21(1) within 1 year of notification under S 1.53(d) must be paid.

Total completion fees \$ 797.00

VII.

EXTENSION OF TIME

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(a) ☐ Applicant petitions for an extension of time, the fees for which are set out in 37 CFR 1.17(a)-(d), for the total number of months checked below:

<u>Extension (months)</u>	<u>Fee for other than Small Entity</u>	<u>Fee for Small Entity</u>
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 400.00	\$200.00
<input type="checkbox"/> three months	\$ 920.00	\$460.00
<input type="checkbox"/> four months	\$1440.00	\$720.00
<input type="checkbox"/> five months	\$1960.00	\$985.00

If an additional extension of time is required please consider this a petition therefor.

(check and complete the next item, if applicable)

☐ An extension for _____ months has already been secured and the fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

or

(b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

VIII.

TOTAL FEE DUE

The total fee due is

Completion fee(s) \$ 797.00

Extension fee (if any) \$ 0.0

TOTAL FEE DUE \$ 797.00

IX.

PAYMENT OF FEES

- ☒ enclosed is a check in the amount of \$ 837.00 (includes assignment recordal)
- ☐ charge Account No. _____ in the amount of \$ _____. A duplicate of this request is attached.

NOTE: Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 CFR 1.22(b).

X.

AUTHORIZATION TO CHARGE ADDITIONAL FEES

WARNING: ACCURATELY COUNT CLAIMS, ESPECIALLY MULTIPLE DEPENDANT CLAIMS, TO AVOID UNEXPECTED HIGH CHARGES IF EXTRA CLAIMS ARE AUTHORIZED.

- ☒ The Commissioner is hereby authorized to charge the following additional fees which may be required by this paper and during the pendency of this application to Account No. 06-2360.
- ☒ 37 CFR 1.16 (a), (f) or (g) (filing fees)
- ☒ 37 CFR 1.16 (b), (c) and (d) (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 CFR 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

- ☒ 37 CFR 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)
- ☒ 37 CFR 1.17 (application processing fees)

WARNING: WHILE 37 CFR 1.17(A), (B), (C) AND (D) DEAL WITH EXTENSIONS OF TIME UNDER S 1.136(A) THIS AUTHORIZATION SHOULD BE MADE ONLY WITH THE KNOWLEDGE THAT: "SUBMISSION OF THE APPROPRIATE EXTENSION FEE UNDER 37 CFR 1.136(A) IS TO NO AVAIL UNLESS A REQUEST OR PETITION FOR EXTENSION IS FILED." (EMPHASIS ADDED). NOTICE OF NOVEMBER 5, 1985 (1060 O.G. 27).

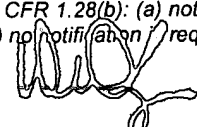
- ☐ 37 CFR 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 CFR 1.311(b))

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 CFR 1.311(b).

NOTE: 37 CFR 1.28(b) requires "Notification of any change in loss of entitlement to small entity status must be filed in the application ... prior to paying, or at the time of paying ... issue fee". From the wording of 37 CFR 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification required if the change is to another small entity.

Reg. No. 29,243

Telephone No.: (262) 783 - 1300


(Signature of Attorney)

Daniel D. Ryan
(Type or Print Name of Attorney)
RYAN KROMHOLZ & MANION, S.C.
P.O. Box 26618
Milwaukee, Wisconsin 53226

9345.17121-CIP A



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Todd A. Thompson et al.

Group No.: 3737

Serial No.: 09/935,908

Examiner: Unknown

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For: Systems and Methods for Applying Ultrasonic Energy to the Thoracic Cavity

Commissioner of Patents and Trademarks
Washington, D.C. 20231

STATEMENT BY ATTORNEY THAT APPLICATION FILED IN PTO IS THE
ONE INVENTOR(S) EXECUTED BY SIGNING DECLARATION

I, Daniel D. Ryan, Registration No. 29,243, of RYAN KROMHOLZ & MANION, S.C.,
P.O. Box 26618, Milwaukee, Wisconsin 53226-0618, {(262) 783-1300} state I am an
attorney for this application and the application identified above is the application
which the inventor(s) executed by signing the declaration which is being submitted
herewith.

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is
being deposited with the United States Postal Service on the date shown below with sufficient postage as
first class mail in an envelope addressed to the: Commissioner of Patents and Trademarks, Washington,
D.C. 20231.

Date 13 November 2001

By

Mary Szollar

(Typed Name of Person Signing Paper)



COMBINED DECLARATION AND POWER OF ATTORNEY
(ORIGINAL, DESIGN, NATIONAL STAGE OF PCT, SUPPLEMENTAL, DIVISIONAL,
CONTINUATION OR CIP)

As a below named inventor, I hereby declare that:

TYPE OF DECLARATION

This declaration is of the following type: *(check one applicable item below)*

- ☐ original
☐ design
☐ supplemental

NOTE: If the declaration is for an International Application being filed as a divisional, continuation or continuation-in-part application do not check next item; check appropriate one of last three items.

- ☐ national stage of PCT

NOTE: If one of the following 3 items apply then complete and also attach ADDED PAGES FOR DIVISIONAL, CONTINUATION OR CIP.

- ☐ divisional
☐ continuation
☒ continuation-in-part (CIP)

INVENTORSHIP IDENTIFICATION

WARNING: If the inventors are each not the inventors of all the claims an explanation of the facts, including the ownership of all the claims at the time the last claimed invention was made, should be submitted.

My residence, post office address and citizenship are as stated below next to my name. I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

TITLE OF INVENTION

 Systems and Methods for Applying Ultrasonic Energy to the Thoracic Cavity

SPECIFICATION IDENTIFICATION

the specification of which: *(complete (a), (b) or (c))*

- (a) ☐ is attached hereto.
 (b) ☒ was filed on 23 August 2001 as ☒ Serial No. 09/935,908
 or ☐ Express Mail No., as Serial No. not yet known _____
 and was amended on _____ (if applicable).

NOTE: Amendments filed after the original papers are deposited with the PTO which contain new matter are not accorded a filing date by being referred to in the declaration. Accordingly, the amendments involved are those filed with the application papers or, in the case of a supplemental declaration, are those amendments claiming matter not encompassed in the original statement of invention or claims. See 37 CFR 1.67.

- (c) ☐ was described and claimed in PCT International Application No. _____
 filed on _____ and as amended under PCT Article 19 on
 _____ (if any).

ACKNOWLEDGMENT OF REVIEW OF PAPERS AND DUTY OF CANDOR

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37, Code of Federal Regulations, § 1.56

(also check the following item, if desired)

- ☐ In compliance with this duty there is attached an information disclosure statement in accordance with 37 CFR 1.98.

PRIORITY CLAIM (35 U.S.C. § 119)

I hereby claim foreign priority benefits under Title 35, United States Code, § 119 of any foreign application(s) for patent or inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed.

(complete (d) or (e))

- (d) ☒ no such applications have been filed.
- (e) ☐ such applications have been filed as follows.

NOTE: Where item (c) is entered above and the International Application which designated the U.S. itself claimed priority check item (e), enter the details below and make the priority claim.

A. PRIOR FOREIGN/PCT APPLICATION(S) FILED WITHIN 12 MONTHS (6 MONTHS FOR DESIGN) PRIOR TO THIS APPLICATION AND ANY PRIORITY CLAIMS UNDER 35 U.S.C. S 119

COUNTRY (OR INDICATE IF PCT)	APPLICATION NUM- BER	DATE OF FILING (day, month, year)	PRIORITY CLAIMED UNDER 37 USC 119
			<input type="checkbox"/> YES NO <input type="checkbox"/>
			<input type="checkbox"/> YES NO <input type="checkbox"/>
			<input type="checkbox"/> YES NO <input type="checkbox"/>
			<input type="checkbox"/> YES NO <input type="checkbox"/>
			<input type="checkbox"/> YES NO <input type="checkbox"/>

ALL FOREIGN APPLICATION(S), IF ANY FILED MORE THAN 12 MONTHS
(6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION

NOTE: If the application filed more than 12 months from the filing date of this application is a PCT filing forming the basis for this application entering the United States as (1) the national stage, or (2) a continuation, divisional, or continuation-in-part, then also complete ADDED PAGES TO COMBINED DECLARATION AND POWER OF ATTORNEY FOR DIVISIONAL, CONTINUATION OR CIP APPLICATION for benefit of the prior U.S. or PCT application(s) under 35 U.S.C. S 120.

POWER OF ATTORNEY

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith. (List name and registration number)

Daniel D. Ryan (29,243)
Joseph A. Kromholz (34,204)
John M. Manion (38,957)
Arnold J. Ericson (16,879)

Allan O. Maki (20,623)
Patricia Jones (46,318)
Daniel R. Johnson (46,204)
Laura A. Dable (46,436)

(check the following item, if applicable)

[] Attached as part of this declaration and power of attorney is the authorization of the above-named attorney(s) to accept and follow instructions from my representative(s).

SEND CORRESPONDENCE TO

DIRECT TELEPHONE CALLS TO:

Daniel D. Ryan
RYAN KROMHOLZ & MANION, S.C.
Post Office Box 26618
Milwaukee, Wisconsin 53226-0618

Daniel D. Ryan
PHONE CALLS
(262) 783 - 1300

DECLARATION

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

SIGNATURE(S)

NOTE: Carefully indicate the family (or last) name as it should appear on the filing receipt and all other documents.

Full name of sole or first inventor

Todd (GIVEN NAME) A (MIDDLE INITIAL OR NAME) Thompson (FAMILY (OR LAST NAME))
 Inventor's signature Todd A Thompson
 Date 10/29/01 Country of Citizenship US
 Residence (City, State/Country) San Jose, California
 Post Office Address 3140 Rubino Drive #111 ~~4030 Glen Brook Avenue~~
San Jose, California 95125

Full name of second joint inventor, if any

Michael (GIVEN NAME) J (MIDDLE INITIAL OR NAME) Horzewski (FAMILY (OR LAST NAME))
 Inventor's signature Michael J Horzewski
 Date 10/29/01 Country of Citizenship US
 Residence (City, State/Country) San Jose, California
 Post Office Address 6032 Running Springs Road
San Jose, California 95135

Full name of third joint inventor, if any

Veijo (GIVEN NAME) I (MIDDLE INITIAL OR NAME) Soursa, Ph.D. (FAMILY (OR LAST NAME))
 Inventor's signature Veijo I Soursa
 Date 10/29/01 Country of Citizenship FINLAND
 Residence (City, State/Country) Sunnyvale, California
 Post Office Address 1402 Kitimat Place
Sunnyvale, California 94087

Full name of fourth joint inventor, if any

(GIVEN NAME) (MIDDLE INITIAL OR NAME) (FAMILY (OR LAST NAME))
 Inventor's signature _____
 Date _____ Country of Citizenship _____
 Residence (City, State/Country) _____
 Post Office Address _____

Full name of fifth joint inventor, if any

(GIVEN NAME) (MIDDLE INITIAL OR NAME) (FAMILY (OR LAST NAME))
 Inventor's signature _____
 Date _____ Country of Citizenship _____
 Residence (City, State/Country) _____
 Post Office Address _____

CHECK PROPER X(ES) FOR ANY OF THE FOLLOWING ADDED PAGE(S) WHICH
FORM A PART OF THIS DECLARATION

[] Signature for sixth and subsequent joint inventors. Number of pages added _____

* * *

[] Signature by administrator(trix), executor(trix) or legal representative for deceased or incapacitated inventor. Number of pages added _____

* * *

[] Signature for inventor who refuses to sign or cannot be reached by person authorized under 37 CFR 1.47. Number of pages added _____

* * *

[X] Added pages to combined declaration and power of attorney for divisional, continuation, or continuation-in-part (CIP) application.

[X] Number of pages added 2

* * *

[] Authorization of attorney(s) to accept and follow instructions from representative

* * *

(If no further pages form a part of this declaration then end this declaration with this page and check the following item:)

[] This declaration ends with this page



Attorney's Docket No. 9345.17121-CIP A

**ADDED PAGE TO COMBINED DECLARATION AND POWER OF ATTORNEY
FOR DIVISIONAL, CONTINUATION OR C-I-P APPLICATION**

(complete this part only if this is a divisional, continuation or C-I-P application)

CLAIM FOR BENEFIT OF EARLIER U.S./PCT APPLICATION(S) UNDER 35 U.S.C. 120

I hereby claim the benefit under Title 35, United States Code, S 120 of any United States application(s) or PCT international application(s) designating the United States of America that is/are listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in that/those prior application(s) in the manner provided by the first paragraph of Title 35, United States Code, S 112, I acknowledge the duty to disclose information that is material to the examination of this application, namely, information where there is substantial likelihood that a reasonable Examiner would consider it important in deciding whether to allow the application to issue as a patent, which occurred between the filing date of the prior application(s) and the national or PCT international filing date of this application.

**PRIOR U.S. APPLICATIONS OR PCT INTERNATIONAL APPLICATIONS
DESIGNATING THE U.S. FOR BENEFIT UNDER 35 USC 120:**

Status
(CHECK ONE)

U.S. APPLICATIONS	U.S. FILING DATE	Patented	Pending	Abandoned
1. 09/645,662	24 August 2000		X	
2. 0 /				
3. 0 /				

PCT APPLICATIONS DESIGNATING THE U.S.

PCT APPLICATION NO.	PCT FILING DATE	U.S. SERIAL NOS. ASSIGNED (if any)
4. _____	_____	_____
5. _____	_____	_____
6. _____	_____	_____

35 USC 119 PRIORITY CLAIM, IF ANY, FOR ABOVE LISTED U.S./PCT APPLICATIONS

**DETAILS OF FOREIGN APPLICATION FROM WHICH PRIORITY APPLICATION
CLAIMED UNDER 35 USC 119**

Above Appln. No.	Country	Application No.	Date of filing (day, month, year)	Date of issue (day, month, year)
1.				
2.				
3.				
4.				
5.				
6.				